

**REMARKS:**

**Status Of Claims**

Claims 1-8, 13, 14, and 30-39 were previously pending. Claims 1 and 31 have been amended. Thus, claims 1-8, 13, 14, and 30-39 are currently pending in the application with claims 1 and 31 being independent.

**Office Action**

In the Office Action, the Examiner rejected claims 1-8, 13, 14, and 31-39 under 35 U.S.C. § 112. Specifically, the Examiner asserted that there is no support for the limitation directed to the case conforming to the tray found in claims 1 and 31. The Examiner's attention is called to Figures 19-26, which show the case conforming to the tray and the discussion thereof on pages 24-28. Specifically, on page 24, lines 16-17, the specification discloses that the "navigation assembly 177i includes a carrying case 178i sized and configured to fit within a tray 14i". Furthermore, on page 25, lines 6-8, the specification discloses that the "case 187i is preferably sized to fit within the tray14i such that no securing mechanism is needed to secure the case 178i within the tray 14i". As the Examiner has cited references that are markedly different than the present invention, it appears that the Examiner doesn't fully appreciate the intent behind the claim language. Thus, Applicant was forced to expand on the intent behind the claim language. This expansion is, however, fully described and supported by the figures and specification.

The Examiner also rejected claims 1-8, 13, and 31-36 under 35 U.S.C. § 103(a) as being unpatentable over Ross et al., U.S. Patent No. 5,859,628, in view of Lewis, GB 2,405,049, and Susko et al., U.S. Patent No. 5,996,866. The Examiner also rejected claims 14 and 38 under 35 U.S.C. § 103(a) as being unpatentable over Ross in view of Lewis in further view of Ockerse et al., U.S. Patent No. 6,928,366. The Examiner also rejected claims 30, 37, and 39 under 35 U.S.C. § 103(a) as being unpatentable over Ross in view of Lewis and Yaski et al., U.S. Patent Application No. 2001/0040109. Applicant respectfully submits that the currently pending claims distinguish the present invention from Ross, Lewis, Susko, Ockerse, Yaski, and the other prior art references of record, taken alone or in combination with each other.

Specifically, claim 1 recites “a carrying case sized and configured to removably fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, wherein the case is configured to conform to the tray”. Claim 2 further recites “wherein the tray is originally installed in the vehicle during manufacture of the vehicle”. Claim 3 recites “wherein the tray is positioned on a dashboard of the vehicle”. Claim 30 recites “wherein the carrying case includes a base and a hinged lid, such that when the navigational device is pivoted to a flat, nesting position within the case, the lid is operable to enclose the navigational device, and when the navigational device is pivoted upwards in a viewing position, the lid is operable to pivot upwards and rest generally against a top of the navigational device”. Claim 31 recites “a carrying case sized and configured to conform to a tray of the vehicle, wherein the tray is originally installed in the

vehicle during manufacture of the vehicle”. Claim 32 recites “wherein the tray is positioned on a dashboard of the vehicle”. Claim 34 “wherein the carrying case includes a base and a hinged lid, such that the lid encloses the base when the case is closed”. Claim 35 recites “wherein the case may easily and quickly be removed from the tray”. Claim 39 recites “wherein the carrying case includes a base and a hinged lid, such that when the navigational device is pivoted to a flat, nesting position within the case, the lid is operable to enclose the navigational device, and when the navigational device is pivoted upwards in a viewing position, the lid is operable to pivot upwards and rest generally against a top of the navigational device”. This configuration can be seen, for example, in figures 19, 20, and 23.

In contrast, neither Ross, Lewis, Susko, Ockerse, nor Yaski disclose “a carrying case sized and configured to removably fit substantially within a tray of the vehicle and configured to substantially enclose the navigational device, wherein the case is configured to conform to the tray”, as claimed in claim 1, or “a carrying case sized and configured to conform to a tray of the vehicle, wherein the tray is originally installed in the vehicle during manufacture of the vehicle”, as claimed in claim 31, much less the limitations of the claims depending therefrom. Simply put, the Examiner has failed to cite prior art references that teach each claim limitation, or even provide the requisite suggestion or motivation to combine such references, and therefore has failed to properly establish a *prima facie* case of obviousness.

Obviousness, it will be appreciated, can be a problematic basis for rejection because the Examiner, in deciding that a feature is obvious, has benefit of the Applicant's disclosure as a blueprint and guide, whereas one with ordinary skill in the art would have no such guide, in which light even an exceedingly complex solution may seem easy or obvious. Furthermore, once an obviousness rejection has been made, the Applicant is in the exceedingly difficult position of having to prove a negative proposition (i.e., non-obviousness) in order to overcome the rejection. For these reasons, MPEP § 2142 places upon the Examiner the initial burden of establishing a *prima facie* case which requires, among other things, that there be identified some motivation or suggestion in the prior art or in the knowledge of one with ordinary skill to modify the reference or to combine reference teachings. If the Examiner fails to establish the requisite *prima facie* case, the rejection is improper and will be overturned. *In re Rijckaert*, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). Only if the Examiner's burden is met does the burden shift to the applicant to provide evidence to refute the rejection.

Specifically, the Examiner must satisfy three criteria in order to establish the requisite *prima facie* case of obviousness: (1) there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine their teachings; (2) there must be a reasonable expectation of success; and (3) ***the prior art reference (or combination of references) must teach or suggest all the claim limitations.*** MPEP §706.02(j), citing *In re Vaeck*, 20 USPQ2d 1438 (Fed. Cir. 1991) (emphasis added).

In meeting this initial burden, the Examiner “cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention”. *In re Fine*, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988). The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on the applicant’s disclosure. *In re Vaeck*, 1442 (Fed. Cir. 1991). Thus, measuring a claimed invention against the standard established by section 103 requires the oft-difficult but critical step of casting the mind back to the time of invention, to consider the thinking of one of ordinary skill in the art, guided only by the prior art references and the then-accepted wisdom in the field. *See e.g., W. L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 USPQ 303, 313 (Fed. Cir. 1983).

Furthermore, “[t]he mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.” *In re Fritch*, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992); *see also In re Gordon*, 221 USPQ 1125, 1127 (Fed. Cir. 1984). Additionally, “the mere possibility that one [element] could be modified or replaced ... does not make the [claim] obvious ‘unless the prior art suggested the desirability of [such a] modification’ or replacement”. *In re Brouwer*, 37 USPQ2d 1663 (Fed. Cir. 1995) (citing *In re Gordon*).

In the present case, neither Ross, Lewis, Susko, Ockerse, nor Yaski even suggest a case being configured to substantially conform to a tray of the vehicle, much less an OEM tray “originally installed in the vehicle during manufacture of the vehicle”. Specifically, while

Ross' cradle 104 is designed to conform to his PDA 102, there is absolutely no teaching or suggestion that Ross' cradle 104 conform to any portion of his vehicle. Neither of Lewis' or Yaski's disclosures even suggest that their inventions could be made to conform to any portion of a vehicle. Actually, quite the opposite. For example, Lewis' invention is designed to be worn on a user's head, and therefore any modification to conform to a vehicle tray, would render Lewis unsuitable for its intended purpose. Similarly, Yaski's invention is designed to be worn on a user's belt, and therefore any modification to conform to a vehicle tray, would render Yaski unsuitable for its intended purpose. On the other hand, there is absolutely no disclosure of Susko's drawer being "easily and quickly ... removed from the tray", as claimed in claim 5. In fact, as Susko's drawer is designed as an integral part of his vehicle console, any modification of Susko's drawer to function as the claimed carrying case would render Susko for its intended purpose. Furthermore, the Examiner cites no art that teaches "wherein the carrying case includes a base and a hinged lid, such that when the navigational device is pivoted to a flat, nesting position within the case, the lid is operable to enclose the navigational device, and when the navigational device is pivoted upwards in a viewing position, the lid is operable to pivot upwards and rest generally against a top of the navigational device", as claimed in claims 30 and 39.

Finally, the Examiner cites no suggestion or motivation, found in the prior art, for combining the references. Rather, the only suggestion is found in the present application itself, thereby rendering the Examiner's combination impermissible hindsight

reconstruction. In fact, as discussed above, the Examiner's proposed modifications would render many of the references unsuitable for their intended purposes, and therefore the Examiner's proposed combination is improper. As a result, the Examiner has failed to properly establish a *prima facie* case of obviousness, and therefore the present obviousness rejections simply cannot be sustained.

The remaining claims all depend directly or indirectly on claims 1 or 31, and are therefore also allowable.

Any additional fee which is due in connection with this amendment should be applied against our Deposit Account No. 501-791. In view of the foregoing, a Notice of Allowance appears to be in order and such is courteously solicited.

Respectfully submitted,

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